

REMARKS

Claims 27-34 and 37-39 are pending in the application.

Claims 27-34 and 37-39 have been rejected.

Claims 27-34 and 37-38 have been cancelled, without prejudice.

New Claims 40-46 have been added.

I. REJECTION UNDER 35 U.S.C. § 103

Claims 27-34 and 37-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,104,924 to Shirai in view of U.S. Patent No. 5,991,760 to Gauvin, et al. The Examiner's rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant

of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

With respect to Claim 39, the Examiner concedes that Shirai does not disclose "... wherein in the off-line mode, when the application program running on the server modifies data at the server, the application program running on the server establishes a data connection with the wireless terminal and updates corresponding data in the virtual memory ..." See, Office Action, p. 7. The Examiner argues that Gauvin, et al. teach this element. See, Office Action, pp. 7-8 (citing abstract; Col. 2, lines 11-29; Col. 5, lines 6-40 and 54-57). To the contrary, Gauvin, et al. teach downloading a copy of a document (database) from an origin server to a local computer, modifying the document (database), and updating the document (database) at the server, upon re-connection of the local computer to the

server. Accordingly, Gauvin, et al. fail to disclose or teach Applicants' invention "wherein in the off-line mode, when the application program running on the server modifies data at the server, the application program running on the server establishes a data connection with the wireless terminal and updates corresponding data in the virtual memory [of the wireless terminal] . . ." See, Claim 39.

Accordingly, Applicants respectfully request withdrawal of the § 103 rejection of Claim 39.

II. NEW CLAIMS 40-46

New Claims 40-46 have been added. Claims 40-41 depend from independent Claim 39.

Applicants believe that new Claims 40-46 are patentable over the cited references, as described above.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

AMENDMENTS WITH MARKINGS TO SHOW CHANGES MADE

Claims 27-34 and 37-38 were canceled, without prejudice.

Claims 40-46 were added herein as follows:

40. A wireless terminal method in accordance with Claim 39 further comprising providing an application program running on the server.

41. A wireless terminal method in accordance with Claim 39 further comprising downloading applets from the server to the wireless terminal.

42. A server method comprising:
providing an application program running on the server;
the application program treating as local virtual memory a memory located on a wireless terminal while a connection between the server and the wireless terminal is established, with read and write access to the memory;

while said connection is established and without wireless terminal user intervention, sending to the wireless terminal a local application program which when run by the wireless terminal allows the wireless terminal read and write access to data in the memory related to the application program while in an off-line mode; and

wherein in the off-line mode, when the application program running on the server modifies

data at the server the application program running on the server establishes a data session with the wireless terminal and updates corresponding data in the virtual memory and when the local application program modifies particular data in the virtual memory the local application program outputs a message, to the server, containing updates for at least some of the particular data.

43. A server method in accordance with Claim 42 further comprising maintaining a mirror version of the local virtual memory.

44. A wireless terminal comprising:

a memory which in an on-line mode is adapted to be treated as local virtual memory by an application program running on a server to read and write data in the virtual memory related to the application program;

a local application program on the wireless terminal which in an off-line mode has read and write access to the data in the memory; and

wherein in the off-line mode, when the application program running on the server modifies data at the server the application program running on the server establishes a data session with the wireless terminal and updates corresponding data in the virtual memory and when the local application program modifies particular data in the virtual memory the local application program outputs a message, to the server, containing updates for at least some of the particular data.

45. A wireless terminal in accordance with Claim 44 further comprising a plurality of keys having dynamically redefinable functions wherein the local application program specifies softkey labels identifying a respective function defined by the application program for at least one of the keys, the local application program comprising the functions defined for at least one of the keys.

46. A wireless terminal in accordance with Claim 45 wherein the local functions comprise at least one function which when executed automatically instigates the establishment of a new connection to the server if one is not already in existence.

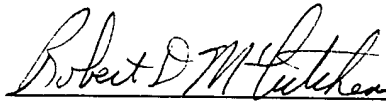
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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Robert D. McCutcheon
Registration No. 38,717

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(214) 922-9221 (main number)
(214) 969-7557 (fax)
E-mail: *rmccutcheon@davismunck.com*